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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/733,691

12/07/2000

Jeffrey D. Carnevali

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DARBY & DARBY P.C.

P.O. BOX 770

Church Street Station

New York, NY 10008-0770

EXAMINER

BAXTER, GWENDOLYN WRENN

ART UNIT

PAPER NUMBER

3632

MAIL DATE

DELIVERY MODE

07/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|-----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/733,691 | CARNEVALI, JEFFREY D. | |
| | Examiner | Art Unit | |
| | Gwendolyn Baxter | 3632 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 1406.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-45, 50, 51, 59, 61-75 and 82-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-45, 50, 51, 59, 61-75 and 82-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/05, 5/06, 1/07</u> . | 6) <input type="checkbox"/> Other: _____ |

This is the sixth office action for serial number 09/733,691, Universally Positionable Mounting Device, filed on December 7, 2000.

Oath/Declaration

In response to the non-final Office action dated December 29, 2005, Applicant submitted a response dated March 29, 2006 canceling claims 38-42, 46-49, 52-58 and 60 and introduced claims 70-94. Subsequently, applicant filed two supplemental amendments dated April 17, 2006 and September 14, 2006. In none of the aforementioned submission has Applicant provided a supplemental reissue oath/declaration as required. Applicant is reminded that specific changes or amendments must be discussed. Specific changes or amendments to the claims must be identified. If new claims are presented, their differences from the original claims must be pointed out. See MPEP Section 1414. A supplemental declaration/oath is required for the claims added. Each amendatory change, when first submitted, must be accompanied by an explanation of the support in the disclosure of the patent for the change (along with any additional comments) on page(s) separate from the page(s) containing the amendment. 37 CFR 1.173(c).

Applicant is reminded that for any error corrected, which is not covered by the original declaration, or supplemental declaration(s), Applicant must submit a supplemental declaration stating that *every error in the patent which was corrected in the present reissue application, and which is not covered by the prior declaration(s)*

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submitted in this application, arose without any deceptive intention on the part of the Applicant. 37 CFR 1.175(b)(1)

Claims 43-45, 50-51, 59, 61, 63, 67-69, 70-75, and 82-87 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Specification

The disclosure is objected to because of the following informalities: since applicant has filed more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. An example of the modified insertion is provided below.

More than one reissue application has been filed for the reissue Patent No. 9,999,999. The reissue applications are application numbers 09/999,994 (the present application), and 09/999,998, which is a continuation reissue of Patent No. 9,999,999.

Please note:

1. This modified insertion must be totally underlined. See 37 CFR 1.173.
2. A supplemental declaration will be required to address this change.

Appropriate correction is required. See MPEP 1451.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 64-66 and 88-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Base claims 35 and 80 have been cancelled, respectively. However, claims 64-66 and 88-90, respectively, are designated to depend upon these cancelled claims. If the base claim has been cancelled, a claim directly or indirectly dependent thereon should be rejected as incomplete. These claims are deemed to be incomplete.

Recapture

Claims 43-45, 50, 51, 58, 59, 61-75, and 82-94 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the

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application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Applicant has provided reissue claims, which are broader than the patented claims, and omits limitations that were added/argued during the original prosecution of the patent to overcome an art rejection(s). Therefore, such an omission in a reissue claim is impermissible recapture. For instance, the reason claims 74, 75 and 76 of the original patent were allowed was due to the inclusion of the limitations of claims 40, 45 and 47 of the original prosecution written in independent form outlined in Amendment F. Similarly, the arguments presented on pages 32-34 of Amendment F are what the applicant believes to make claims 38 and 54 allowable in addition to the modifications of claim 38 in Amendment F. The content of at least one of these limitations should be presented in each of the reissue independent claims to avoid, recapture.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438,

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164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321 (d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-45, 50, 51, 59, 61-75, and 82-94 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37, 39, 42, 47, 49, 52, 55-57, 60, 62-68, 75-85 of U.S. Patent No. 10/300,951. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter recited in the instant claims (for example, the ball and socket comprising the coupling member, reduced neck, deformable material, socket, etc) are also recited in the claims of the '951 application.

Response to Arguments

Applicant's arguments filed September 14, 2006 have been fully considered but they are not persuasive. In response to applicant's arguments that there is no recapture, the reason claims 30, 35 and 37 of the original patent were allowed are the limitations of claims 40, 45 and 47 were written in independent form in amendment F. Since the limitations of 40, 45 and 47, respectively, was added to obviate the rejection. The subsequent deletion of (omission of) limitations in 40, 45 or 47 in the reissue claims would be presumed to be broadening in an aspect of the reissue claims related to

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surrendered subject matter. Accordingly, the reissued claims would be barred by the recapture doctrine. See MPEP 1412, Part B, Example (2), page 1400-19.

Remarks

Applicant is reminded that claims added to the patent must be underlined in their entirety (37 CFR 1.173(d)). Each amendment submission must set forth the status of all patent claims and of all added claims (i.e., "pending" or "canceled") as of the date of the amendment. 37 CFR 1.173(c).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

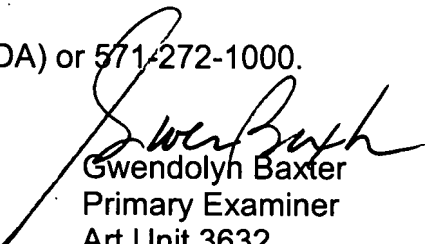
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Baxter whose telephone number is 571-272-6814. The examiner can normally be reached on Monday-Wednesday, 8:30am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gwendolyn Baxter
Primary Examiner
Art Unit 3632

July 25, 2007